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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,965	05/18/2000	MARTHA A. WARPEHOSKI	0769-0420-OX	3222

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LIU, HONG

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1624

DATE MAILED: 10/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/530,965

Applicant(s)

Warpehoski et al.

Examiner

Hong Liu

Art Unit

1624



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Aug 23, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1835 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 4, 6, and 20-36 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 4, 6, and 20-36 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

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DETAILED ACTION

Claims 4, 6, and 20-36 are pending in this application.

This action is in response to the applicants' amendment and reply filed on August 23, 2002.

Response to Arguments

Applicants' arguments filed on August 23, 2002 have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 4 and 20-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Provisos have been included in the claim (see amended claim 4). The proviso lacks description. Even negative limitations require a description. The MPEP at 2173.05(I) Negative Limitation states "Any negative limitation or exclusionary proviso must have basis in the original disclosure. See Ex parte Grasselli, 231USPQ 393 (Bd. App. 1983) aff'd mem., 738 F. 2d 453 (Fed. Cir. 1984)" and further, "Any claim containing a negative limitation

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which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.” In the instant case, the new concept that has been introduced by the proviso is the specific relationships between R2, Y, h, Q, and R1. This specific relationship of connectivity was previously not disclosed. This notion that the definition of one variable depends on the definitions of other variables is new. The definition of a variable is no longer independent.

Claim Rejections - 35 USC § 102

The rejection to claims under 35 U.S.C. 102(b) is hereby withdrawn in view of applicants' amendment of the claims by inserting a series of provisos.

Claim Rejections - 35 USC § 103

Claim 6 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. (EP 0780386). Applicants' arguments have been fully considered but are not found persuasive. The species in claim 6 differ from the reference compounds only in the substituent at the 2-position of propionic acid, i.e. hydroxy v. H. Hydrogen and hydroxy groups are not patentably distinct from each other in the prior art. OH v. H is not deemed patentably distinct in the absence of superior or unexpected properties. See *In re Wood* 199 USPQ 137; *In re Lohr* 137 USPQ 548 regarding the addition of a Me group to a known compound. Furthermore, applicants should note a replacement of two hydrogen atoms on a known compounds with two lower alky radicals has

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been held to be *prima facie* obvious due to the close structural similarity. Note *In re Hoke*, 195 USPQ 148 and *Ex parte Fauque*, 121 USPQ 425. Thus, it would have been obvious to one skilled in the art at the time the instant invention was made to expect instant compounds to possess the same use as the applied art in view of the close structural similarity outlined above.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are

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unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl
October 10, 2002



RICHARD L. RAYMOND
PRIMARY EXAMINER
Mukund Shah
Supervisory Patent Examiner
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